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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/731,629

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Steven M. French

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05/02/2006

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EXAMINER

NGUYEN, THANH T

ART UNIT

PAPER NUMBER

2144

DATE MAILED: 05/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/731,629

Applicant(s)

FRENCH ET AL.

Examiner

Tammy T. Nguyen

Art Unit

2144

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE (3) MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on February 21, 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 11-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9, 11-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 December 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |



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Detailed Office Action

1. In view of the Appeal Brief filed on February 21, 2006, PROSECUTION IS HEREBY REOPENED. A new ground of rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

- (1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,
- (2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

2. Claims **1-9, 11-27** are reopen for examination.

Drawings

3. The drawings are objected to under 37 CFR 1.83(a) because they fail to show all limitations in the claims as described in the specification. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). A proposed drawing correction or corrected drawings are required in reply to the

Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1, 13, and 23 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. "concurrently and persistently unable to locate within the specification.

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 13 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subjected matter.

8. Claim 13 is not limited to tangible embodiments. The claim recited "Computer program comprising..." is nonstatutory. Since claim 8 recited 'computer program

product..." is just limited to a functional descriptive materials" consists of computer program per se, instead of being defined as including tangible embodiments (i.e., a computer readable storage medium such as memory device, storage medium, etc.,). As such, the claim is not limited to statutory subject matter and is therefore nonstatutory. To overcome this type of 101 rejection, examiner suggests applicants to amend the claim to include computer readable storage medium to store computer codes (for example, the claim should be amended as "A computer program embedded a program code in a computer readable medium...." of claim 1 ..." see MPEP 2106 section V. DETERMINE WHETHER THE CLAIMED INVENTION COMPLIES WITH 35 U.S.C. 101 under subsection 1. Nonstatutory subject matter.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-9, 11-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beelitz et al., (hereinafter Beelitz) U.S. Patent No. 6,182,275 in view of Cohn et al., (hereinafter Cohn) U.S. Patent No. 6,411,684.

11. As to claim 1, Beelitz teaches the invention as claimed, including a method of

generating a list of target devices to be configured in communication with a server, comprising: creating a first list of target devices to be configured (col.7, lines 35-40, lines 48-51); identifying at least one addressed target device having an associated network address (Fig.1, Target computer system 137 associated with network connection 110, and col.15, lines 55-60); modifying the first list of target devices using the addressed target device (col.16, lines 4-10); and generating a modified list of target devices to be configured (col.18, lines 5-10), wherein the target devices are to be remotely booted by server (col.14, line 65 to col.15, line 7). But Beelitz does not explicitly teach persistently and concurrently in communication with the server by means of a network. However, Cohn teaches persistent and concurrent in communication with the server by means of a network (see col.10, lines 33-50, and col.34, lines 15-28).). It would have been obvious to one of ordinary skill in the art at the time of the invention was made to implement the teachings of Cohn into the computer system of Beelitz to have persistent and concurrent in communication with the server by means of a network because it would have been provided specific functions that can operating or occurring at the same time and continuing without change in function or structure in the network.

12. As to claim 2, Beelitz teaches the invention as claimed, wherein the addressed target device is listed in at least one information source (col.7, lines 35-40).

13. As to claim 3, Beelitz teaches the invention as claimed, further comprising: adding the associated network address of the addressed target device to the first list of target devices (col.3, lines 5-15).

14. As to claim 4, Beelitz teaches the invention as claimed, further comprising: adding the addressed target device having an associated network address to the first list of target devices (col.17, lines 20-30).

15. As to claim 5, Beelitz teaches the invention as claimed, further comprising: removing the addressed target device having an associated network address from the first list of target devices (col.4, lines 59-64).

16. As to claim 6, Beelitz teaches the invention as claimed, further comprising: pre-configuring at least one pre configured target device (col.18, lines 60-67, and lines 5-10).

17. As to claim 7, Beelitz teaches the invention as claimed, further comprising: adding the pre configured target device to the first list (col.18, lines 60-67).

18. As to claim 8, Beelitz teaches the invention as claimed, further comprising:
determining if a target device has an associated network address; and removing the target device from the modified list of target devices if it does not have an associated network address (col.7, lines 35-40).

19. As to claim 9, Beelitz teaches the invention as claimed, further comprising:
configuring the target devices on the modified list (col.7, lines 4-56).

20. As to claim 11, Beelitz teaches the invention as claimed, further comprising:
examining log data to determine if a target device has an associated network address (Fig. 1
Target computer and associated network 110).

21. As to claim 12, Beelitz teaches the invention as claimed, further comprising:
providing the modified list to the server (col.1, lines 40-55).

22. As to claim 13, Beelitz teaches the invention as claimed, including a computer
program product in a computer usable medium for generating a list of target devices to be
configured in communication with a server, comprising: means for creating a first list of target
devices to be configured (col.17, lines 35-40, and lines 48-50); means for identifying with an
identification at least one addressed target device having an associated network address (col.15,
lines 55-60); means for modifying the first list of target devices using the addressed target device
(col.16, lines 4-10); and means for generating a modified list of target devices to be configured
(col.18, lines 5-10) wherein the target devices are to be remotely booted by server (col.14, line
65 to col.15, line 7). But Beelitz does not explicitly teach persistently and concurrently in
communication with the server by means of a network. However, Cohn teaches persistent and
concurrent in communication with the server by means of a network (see col.10, lines 33-50, and
col.34, lines 15-28).). It would have been obvious to one of ordinary skill in the art at the time
of the invention was made to implement the teachings of Cohn into the computer system of
Beelitz to have persistent and concurrent in communication with the server by means of a

network because it would have been provided specific functions that can operating or occurring at the same time and continuing without change in function or structure in the network.

23. As to claim 14, Beelitz teaches the invention as claimed, further comprising: means for storing the identification of the addressed target device (Fig.1, Target computer system 137).

24. As to claim 15, Beelitz teaches the invention as claimed, further comprising: means for adding the associated network address of the addressed target device to the first list of target devices (col.3, lines 5-15).

25. As to claim 16, Beelitz teaches the invention as claimed, further comprising: means for adding the addressed target device having an associated network address to the first list of target devices (col.3, lines 5-15).

26. As to claim 17, Beelitz teaches the invention as claimed, further comprising: means for removing the addressed target device having an associated network address from the first list of target devices (col.7, lines 35-40).

27. As to claim 18, Beelitz teaches the invention as claimed, further comprising: means for pre configuring at least one target device listed in the first list (col.7, lines 45-50).

28. As to claim 19, Beelitz teaches the invention as claimed, further comprising: means

for removing a target device without an associated network address from the modified list of target devices (col.8, lines 40-45).

29. As to claim 20, Beelitz teaches the invention as claimed, further comprising: means for configuring the target devices listed in the modified list.

30. As to claim 21, Beelitz teaches the invention as claimed, further comprising: means for examining packet data to determine if a target device has an associated network address (Fig.1 associated network 110).

31. As to claim 22, Beelitz teaches the invention as claimed, further comprising: means for examining log data to determine if a target device has an associated network address (Fig.1 target computer system 137 associated with network 110).

As to claim 23, Beelitz teaches the invention as claimed, including a data processing system, the system including target devices and a server, wherein the target devices are persistently and concurrently in communication with the server by means of a network, comprising: means for creating a first list of target devices to be configured (see col.7, lines 35-40, lines 48-50); means for identifying at least one addressed target device having an associated network address (see col.15, lines 55-60); means for comparing the addressed target device to the target devices on the first list (see col.10, lines 10-52, col.16, lines 4-10); and means for generating a modified list of target devices to be configured based on the addressed target device (see col.18, lines 5-10, and

col.14, line 65 to col.15, line 7). But Beelitz does not explicitly teach persistently and concurrently in communication with the server by means of a network. However, Cohn teaches persistent and concurrent in communication with the server by means of a network (see col.10, lines 33-50, and col.34, lines 15-28). It would have been obvious to one of ordinary skill in the art at the time of the invention was made to implement the teachings of Cohn into the computer system of Beelitz to have persistent and concurrent in communication with the server by means of a network because it would have been provided specific functions that can operating or occurring at the same time and continuing without change in function or structure in the network.

32. As to claim 24, Beelitz teaches the invention as claimed, further comprising: means for storing information about the addressed target device (see col.7, lines 35-40).

33. As to claim 25, Beelitz teaches the invention as claimed, further comprising: means for configuring at least one target device (see col.18, lines 5-10).

34. As to claim 26, Beelitz teaches the invention as claimed, further comprising: means for determining if a target device has an associated network address (Fig.1 associated network 110).

35. As to claim 27, Beelitz teaches the invention as claimed, further comprising: creating a router list of target devices (see col.7, lines 35-40, lines 48-50); comparing the router list and the first list of target devices, and wherein modifying the first list of target devices using the

addressed target device comprises modifying the first list of target devices based on the comparison (see col.10, lines 10-52, col.16, lines 4-10).

Response to Arguments

36. Applicant's arguments filed on February 21, 2006 have been fully considered, however they are not persuasive because of the following reasons:

37. Applicants argue that Beelitz does not disclose the target devices are persistently and concurrently in communication with the server by mean of a network. In response to Applicant's argument, the Patent Examiner maintain the rejection because Beelitz does show the target device in communication with the terminal. Which could possible mean simultaneously in communication with each other. However, Beelitz does not explicitly go into the detail of persistently and concurrently in communication. Therefore, in Beelitz clearly teaches the cited limitation in the claimed.

38. Therefore, the Examiner asserts that cited prior arts teach or suggest the subject matter broadly recited in independent claims 1, 13, and 23. Claims 2-12, 14-22, and 24-27 are also rejected at least by the virtue of their dependency on independent claims and by other reasons set forth in the previous office action.

39. Accordingly, claims 1-27 are respectfully rejected.

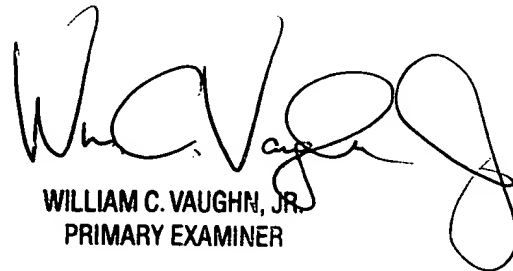
Conclusion

Art Unit: 2144

40. Any inquiries concerning this communication or earlier communications from the examiner should be directed to **Tammy T. Nguyen** who may be reached via telephone at **(571) 272-3929**. The examiner can normally be reached Monday through Friday between 8:00 a.m. and 5:00 p.m. eastern standard time.

If you need to send the Examiner, a facsimile transmission regarding this instant application, please send it to **(703) 872-9306**. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's Supervisor, **VAUGHN JR WILLIAM**, may be reached at **(571) 272-3922**.

TTN
April 25, 2006



WILLIAM C. VAUGHN, JR.
PRIMARY EXAMINER